REMARKS

Claims 1-29 are pending in the present application. The Examiner objected to the specification, abstract and claim 28. In addition, the Examiner rejected claims 1, 12, 15, 26, and 29 under 35 U.S.C. §112, second paragraph, and rejected claims 1-29 under 35 U.S.C. §103(a). Applicants have replaced the original abstract with a substitute abstract, and have amended the specification and claim 28. No new matter has been introduced.

Specification Objections

The Examiner objected to the lack of a specific reference to a priority application in the specification. Applicant has amended the specification to include such as specific priority reference. In addition, the Examiner objected to the presence of embedded hyperlinks on page 19, line 23, page 20, line 1, and page 53, lines 22-23. Applicant has amended the specification to remove the objected to hyperlinks. Reconsideration and withdraw of these objections are respectfully requested.

Abstract Objections

The Examiner objected to the abstract for containing more than 150 words. Applicant has provided a substitute abstract that contains 150 or fewer words. Reconsideration and withdraw of this objection are respectfully requested.

Claim Objections

The Examiner objected to claim 28 for an apparent incorrect claim dependency. Applicant has amended claim 28 to depend from claim 26 instead of claim 25, as suggested by the Examiner. Applicant thanks the Examiner for bringing this informality to his attention. Reconsideration and withdraw of this objection are respectfully requested.

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Section 112 Rejections

The Examiner rejected claims 1, 12, 15, 26, and 29 under 35 U.S.C. §112, second paragraph, as being indefinite. In particular, the Examiner was unclear as to the meaning of the limitation "capable of" in each of the rejected claims.

Applicant responds by noting that the phrase "capable of" refers to the capability of the class or method of performing a particular action at runtime. Referring to claim 1, the phrase "wherein each of the classes within set A is capable of, during execution of the program, causing loading of a class outside of set A", means that, while the program is executing, a class in set A can cause loading of a class outside of class A, but is not required to do so. Claim 1 is directed to identifying a set A of classes in the program, wherein each of the classes within the set A is capable of, during execution of the program, causing loading of a class outside of the set A, not to whether, during execution of the program, a class in Set A causes loading of a class outside of the set A.

Similarly, the phrase in claim 1 "a first set of method calls belonging to the classes in the set A that, during execution of the program, are capable of calling only methods belonging to a class within the set A", means that, while the program is executing, a method belonging to a class in set A can call a method belonging to a class of set A, but is not required to do so, and the phrase "a second set of method calls belonging to the classes in the set A that, during execution of the program, are capable of calling methods belonging to a class outside the set A", means that, while the program is executing, a method belonging to a class in set A can call a method belonging to a class outside of the set A, but is not required to do so.

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Similar considerations apply to the "capable of" phrases in claims 12, 15, 26, and 29. Reconsideration and withdraw of these objections are respectfully requested.

Section 103 Rejections

The Examiner rejected independent claims 1 and 26 under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 6,546,551 (Sweeney, *et al.*) in view of Berg, Advanced JAVA 2nd Edition, 1999. Independent claims12, 15 and 29 were rejected under 35 U.S.C. §103(a) as obvious over Sweeney and Berg in view of U.S. Patent No. 6,631,518 (Bortnikov, *et al.*).

Further, the Examiner rejected dependent claim 2 under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 6,546,551 (Sweeney, *et al.*) in view of Berg, Advanced JAVA 2nd Edition, 1999. Claims 3 and 27 were rejected under 35 U.S.C. §103(a) as obvious over Sweeney and Berg in view of U.S. Patent No. 6,622,300 (Krishnaswamy, *et al.*). Claims 4, 6-8, 11, 24, and 28 were rejected under 35 U.S.C. §103(a) as obvious over Sweeney and Berg in view of Bortnikov. Claim 5 was rejected under 35 U.S.C. §103(a) as obvious over Sweeney and Berg in view of U.S. Patent No. 6,289,506 (Kwong, *et al.*). Claim 9 was rejected under 35 U.S.C. §103(a) as obvious over Sweeney and Berg in view of Liang, *et al.*, Dynamic Class Loading in the Java Virtual Machine, 1998. Claim 10 was rejected under 35 U.S.C. §103(a) as obvious over Sweeney, Berg, and Bortnikov in view of Fitzgerald, *et al.*, Marmot: An Optimization Compiler for JAVA, 1999. Claim 13 was rejected under 35 U.S.C. §103(a) as obvious over Sweeney, Berg and Bortnikov in view of Kwong. Claims 14 and 18 were rejected under 35 U.S.C. §103(a) as obvious over Sweeney, Berg and Bortnikov in view of Fitzgerald. Claim 16 was rejected under 35 U.S.C. §103(a) as obvious over Sweeney, Berg and Bortnikov in view of U.S. Patent No. 5,987,256 (Wu, *et al.*). Claim 17

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was rejected under 35 U.S.C. §103(a) as obvious over Sweeney, Berg and Bortnikov in view of DeFouw, *et al.*, Fast Interprocedural Class Analysis, 1998. Claims 19-23 and 25 were rejected under 35 U.S.C. §103(a) as obvious over Sweeney, Berg and Bortnikov in view of Grove, *et al.*, Call Graph Construction in Object-Oriented Languages, 1997.

Applicant respectfully traverses these rejections.

Applicant notes that the assignee of both Sweeney and Bortnikov, International Business Machines Corporation (IBM) of Armonk, New York, is the assignee of the present application. Applicant further notes that 35 U.S.C. §103(c) states that "Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of **section 102** of this title, shall not preclude patentability under this section where the subject matter and claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." Section 102(e)(2) states, in relevant part, that "A person shall be entitled to a patent unless the invention was described in a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent".

The Sweeney patent issued on April 8, 2003, on an application filed on September 28, 1999. The Bortnikov patent issued on October 7, 2003, on an application filed on March 19, 1997. Applicants claim a filing date of March 8, 2000. Both Sweeney and Bortnikov would have qualified as prior art under section 102(e), but neither Sweeney nor Bortnikov can be applicable as prior art against the present application under section 103(c).

Berg discloses a class loader that can load a class from a different domain at runtime. Berg does not disclose the remaining limitations of Applicant's method of analysis as

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claimed in independent claims 1, 12, 15, 26 and 29. Thus, without Sweeney and/or Bortnikov, a *prima facie* case of obviousness of claims 1, 12, 15, 26 and 29 cannot be sustained. Reconsideration and withdraw of these rejections are respectfully requested.
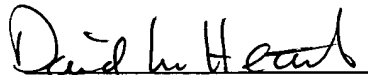
Claims 2-11 depend from claim 1, and are thus patentable for at least the same reasons as claim 1. Claims 13-14 depend from claim 12, and are thus patentable for at least the same reasons as claim 12. Claims 16-25 depend from claim 15, and are thus patentable for at least the same reasons as claim 15. Claims 27-28 depend from claim 26, and are thus patentable for at least the same reasons as claim 26. Reconsideration and withdraw of these rejections are respectfully requested.

CONCLUSION

Applicant urges that claims 1-29, as amended, are in condition for allowance for at least the reasons stated. Early and favorable action on this case is respectfully requested.

Respectfully submitted,

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